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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,218	09/29/2000	Tomio Kimura	970113R/HG	7523

1933 7590 11/27/2001

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 11/27/2001

13

Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

## OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on October 18, 2007☒ This action is FINAL.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.A shortened statutory period for response to this action is set to expire 3 month(s), ~~calendar days~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 6-24, 27-29, 31-33, 35-37, 39-41 and 43-79 are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.☒ Claim(s) 1, 6-15, 27-29, 31-33, 35-37, 39-41 and 43 are rejected.☒ Claim(s) 16-24 and 44-79 are objected to.☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been☐ received.☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of Reference Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

09/678,218

## DETAILED ACTION

Claims 1, 6-24, 27-29, 31-33, 35-37, 39-41 and 43-79 are pending in the application.

### *Reissue Applications*

Since the “aralkyloxycarbonyl” group, in the independent claims, has been deleted from the definition of R<sup>a</sup>, the language “the aralkyl part of said aralkyloxycarbonyl” should be deleted from the claims. Under the definition of “said aryl group”, in the independent claims, “unsubstituted” is misspelled.

Newly added claims 44-79 are objected to because the newly added claims must be entirely underlined. See (37 C.F.R. 1.173(d).

Resubmission is required.

Rejections and objections made in the previous Office Action that does not appear below have been overcome.

*Claim Objections*

Claim 11 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n).

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C.

112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 6-15, 27-29, 31-33, 35-37, 39-41 and 43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No support in the specification or the original filed claims can be found for the now claimed amended invention. Note particularly the

numerous deletions and/or additions to the claims. Applicants' statement for support of claim changes in Attachment 1 has also been considered. However, the alleged support for claim changes was not persuasive.

No support could be found in the specification nor the original filed claims for the genus where R is hydrogen only, R<sup>1</sup> is methyl or amino only, etc. The specification in columns 12-14 discusses preferred classes of compounds of the present invention. However, the now claimed amended invention is not one of those that are discussed in columns 12-14. Therefore, the instant claimed invention as such lacks written description as such in the instant specification. There does appear to be support in the original filed specification and claims for changing the carbon ranges in the alkyl, alkoxy, alkylenedioxy, aryl and/or alkylthio groups defined for either R<sup>3</sup>, R<sup>4</sup>,  $\alpha$  or  $\beta$ .

Claims 1, 6-15, 27-29, 31-33, 35-37, 39-41 and 43 are rejected under 35 U.S.C. 251 as being based upon new matter added to the

patent for which reissue is sought. The added material which is not supported by the prior patent is as follows: R<sup>4</sup> representing a cycloalkyl group having from 3 to 7 carbon atoms and a cycloalkyloxy group having from 3 to 7 carbon atoms.

The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed, should any additional amendments be offered.

***Allowable Subject Matter***

Claims 16-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form

including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

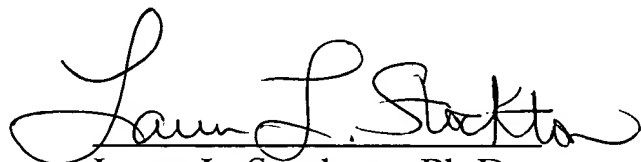
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the

statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235, 308-0196 or 305-3290.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556, 308-4242, 305-1935 or 308-2742.

A handwritten signature in black ink, reading "Laura L. Stockton". The signature is fluid and cursive, with the first name "Laura" and last name "Stockton" clearly distinguishable.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

November 27, 2001